



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/631,884	08/04/2000	Jyotirmoy Paul	50277-0352	1893

29989 7590 04/05/2004

HICKMAN PALERMO TRUONG & BECKER, LLP  
1600 WILLOW STREET  
SAN JOSE, CA 95125

EXAMINER

HILLERY, NATHAN

ART UNIT PAPER NUMBER

2176

DATE MAILED: 04/05/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

2

# Office Action Summary

Application No.

09/631,884

Applicant(s)

PAUL ET AL.

Examiner

Nathan Hillery

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

Art Unit: 2176

### DETAILED ACTION

1. This action is responsive to communications: Amendment filed on 2/13/04.
2. Claims 1 – 25 are pending in the case. Claims 1, 8, 12, and 14 are independent.
3. The objection to the specification has been withdrawn as necessitated by amendment.
4. The objection to the claims has been withdrawn as necessitated by amendment.
5. The rejection of claim 4 under 35 U.S.C. 112, first paragraph as lacking enablement has been withdrawn as necessitated by amendment.
6. The rejection of claims 1 – 20 under 35 U.S.C. 103 as being unpatentable has been withdrawn as necessitated by amendment.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 21 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is no industry understanding or standard for telnet markup language (TML), and the specification does not adequately enable a skilled artisan to recognize, make or use such a language. Consequently, the Office will not consider telnet markup language (TML) in its interpretation of the claimed subject matter.

***Claim Rejections - 35 USC § 103***

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 1 – 3, 5 – 16, and 18 – 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bayeh et al. and further in view of Boag et al.

11. **Regarding independent claim 1**, Bayeh et al. teach that *the role of the data servlet is only to retrieve data from a database* (Column 8, lines 6 – 7) and that *before the data servlet can pass data to another servlet ... it must format that data ... in the preferred embodiment of the present invention, the data servlet formats its output as an XML data stream* (Column 8, lines 13 – 18), which provide for **converting the data ... into an XML output without regard to the device type of the particular client.**

Bayeh et al. do not explicitly teach **identifying the client device type of the particular client, reading metadata that indicates how to convert said XML output to output for said client device type, ... converting the XML output for said client device type, and providing the output for said client device type to said particular client.**

However Boag et al. do teach that ... *the selected style sheets are tailored to the client device ... this is done by inspecting the value of the UserAgent field of the HTTP request header with which the document was requested. This UserAgent value will identify the browser running on the client device. (Alternatively, protocols such as CC/PP may be available for querying the device/browser to determine its capabilities dynamically.)* (Column 10, lines 42 – 50), which provides for **identifying the client device type of the particular client.** In addition, Boag et al. also teach that *selecting*

Art Unit: 2176

*one or more style sheets to transform a particular input document; determining whether a client device is capable of applying the selected style sheets; applying the selected style sheets at the client device when the determining has a positive result; and applying the selected style sheets at a server when the determining has a negative result (Column 4, lines 29 - 36) and that the input document may be encoded in Extensible Markup Language (XML). The style sheets may be encoded in a style sheet language such as Extensible Stylesheet Language (XSL) (Column 5, lines 8 - 11), which provide for reading metadata (XSL) selected based on the client device type, wherein metadata indicates how to convert said XML output to output for said client device type.* Further, it would be obvious to one with ordinary skill in the art at the time of the invention to know that Boag et al.'s invention is capable of ... **converting the XML output for said client device type**, since Boag et al. further teach that XML is emerging as a powerful methodology for representing document content, due to its ability to store data in a self-defining, portable manner. Style sheet languages such as XSL, along with their associated processors, are powerful tools for ... transforming documents encoded in one markup language into other markup languages such as HTML (HyperText Markup Language) or WML (Wireless Markup Language) (Column 2, lines 20 - 28). Also, Boag et al. teach that *if the client device cannot apply style sheets, then they are applied at the server, and the resulting document is sent to the client; otherwise, the document may be sent to the client, where the client will perform the application process (Abstract, lines 7 - 11), which provides for providing the output for said client device type to said particular client.* It would have been obvious to

Art Unit: 2176

one with ordinary skill in the art at the time of the invention to combine the invention of Bayeh et al. with that of Boag et al. because such a combination would allow *dynamic determination of the most appropriate location for applying style sheets* (first sentence of Boag et al.'s Abstract) *used by the rendering servlet for parsing the XML data stream* (last sentence of Bayeh et al.'s Abstract).

12. **Regarding dependent claim 2**, Bayeh et al. do not explicitly teach **reading metadata includes reading an XSL style sheet ... and converting the output includes applying the XSL style sheet to said XML output**. However, Boag et al. do teach that *selecting one or more style sheets to transform a particular input document; determining whether a client device is capable of applying the selected style sheets; applying the selected style sheets at the client device when the determining has a positive result; and applying the selected style sheets at a server when the determining has a negative result* (Column 4, lines 29 - 36) and that *the input document may be encoded in Extensible Markup Language (XML). The style sheets may be encoded in a style sheet language such as Extensible Stylesheet Language (XSL)* (Column 5, lines 8 - 11), which provide for **reading metadata includes reading an XSL style sheet ...**

Further, it would be obvious to one with ordinary skill in the art at the time of the invention to know that Boag et al.'s invention provides for **converting the output includes applying the XSL style sheet to said XML output**, since Boag et al. further teach that *XML is emerging as a powerful methodology for representing document content, due to its ability to store data in a self-defining, portable manner. Style sheet languages such as XSL, along with their associated processors, are powerful tools for*

Art Unit: 2176

... *transforming documents encoded in one markup language into other markup languages such as HTML (HyperText Markup Language) or WML (Wireless Markup Language)* (Column 2, lines 20 – 28). It would have been obvious to one with ordinary skill in the art at the time of the invention to combine the invention of Bayeh et al. with that of Boag et al. because such a combination would allow *dynamic determination of the most appropriate location for applying style sheets* (first sentence of Boag et al.'s Abstract) *used by the rendering servlet for parsing the XML data stream* (last sentence of Bayeh et al.'s Abstract).

13. **Regarding dependent claim 3**, the claim incorporates substantially similar subject matter as claim 5, and is rejected along the same rationale.

14. **Regarding dependent claim 5**, Bayeh et al. teach that *a parser reads a data stream, looking for predefined strings of characters that the parser recognizes, and which indicate to the parser what type of data is represented. In the preferred embodiment, the DTD used in the data servlet specified predefined strings that were used as tags ... and inserted into the XML data stream by the data servlet* (Column 11, lines 53 – 60), which provide for **identifying a data type to which the data corresponds and identifying a data type definition associated with said data type**. Bayeh et al. further teach that *the data servlet formats the database information as an XML data stream. As previously discussed, a DTD is used in this formatting step. The DTD specifies how specific predefined "tags" are to be inserted into the XML data stream* (Column 11, lines 1 – 5), which provide for **converting the data to XML output based on said data type definition**.

Art Unit: 2176

15. **Regarding dependent claim 6**, Bayeh et al. teach that *in the preferred embodiment of the present invention, the data servlet formats its output as an Extensible Markup Language ("XML") data stream (Column 8, lines 17 – 19) and that according to the present invention, the XML data stream 97 is passed on to a "rendering servlet" 85. The function of the rendering servlet 85 is to render the data it receives into a presentation format (Column 8, lines 30 – 35), which provide for the XML output includes display instruction data indicating that said data is to be displayed in a first manner.*

16. **Regarding dependent claim 7**, Bayeh et al. do not explicitly teach **the step of converting the XML output includes the step of generating output for said client device type that causes said data to be displayed in a second manner that is different than said first manner when said client device type is not able to display said data in the first manner.** However, Boag et al. do teach that *the style sheet may contain dynamic parameter syntax for an element such as "<HEIGHT>", so that a scaling factor can be applied during the rendering process to scale the document for the height of the particular display on which it will be presented. The translation process will substitute the retrieved value for the dynamic parameter syntax (Column 12, lines 14 – 20), which provide for the step of converting the XML output includes the step of generating output for said client device type that causes said data to be displayed in a second manner that is different than said first manner when said client device type is not able to display said data in the first manner. It would have been obvious to one with ordinary skill in the art at the time of the invention to combine the*



invention of Bayeh et al. with that of Boag et al. because such a combination would allow *dynamic determination of the most appropriate location for applying style sheets* (first sentence of Boag et al.'s Abstract) *used by the rendering servlet for parsing the XML data stream* (last sentence of Bayeh et al.'s Abstract).

17. **Regarding independent claim 8**, the claim incorporates substantially similar subject matter as claim 1, and is rejected along the same rationale.

18. **Regarding dependent claim 9**, the claim incorporates substantially similar subject matter as claim 2, and is rejected along the same rationale.

19. **Regarding dependent claim 10**, Bayeh et al. do not explicitly teach **the step of sending the second data to the client includes sending the data to a server to which the client is connected through a wireless connection, and then sending the data from the server to the client over said wireless connection**. However, Boag et al., in Figure 2, teach the capability of **the step of sending the second data to the client includes sending the data to a server to which the client is connected through a wireless connection, and then sending the data from the server to the client over said wireless connection**. It would have been obvious to one with ordinary skill in the art at the time of the invention to combine the invention of Bayeh et al. with that of Boag et al. because such a combination would allow *dynamic determination of the most appropriate location for applying style sheets* (first sentence of Boag et al.'s Abstract) *used by the rendering servlet for parsing the XML data stream* (last sentence of Bayeh et al.'s Abstract).

Art Unit: 2176

20. **Regarding dependent claim 11**, the claim incorporates substantially similar subject matter as claim 5, and is rejected along the same rationale.

21. **Regarding independent claim 12**, Bayeh et al. teach, in Figure 4, a **database system (88')** and a **database application operatively coupled to said database system (82')**. . Bayeh et al. also teach that *the role of the data servlet is only to retrieve data from a database 88': it does no presentation formatting of that retrieved data. The data servlet 83 receives the search request 80', queries a database 88' using database query statements 86' appropriate to the particular database, and receives the query results 90'. At that point, the data retrieval function of the data servlet 83 is complete. Before the data servlet 83 can pass data to another servlet for further processing, it must format that data in a manner that allows the next servlet to read and correctly interpret the data. In the preferred embodiment of the present invention, the data servlet formats its output as an Extensible Markup Language ("XML") data stream (Column 8, lines 6 – 18), which provides for said database application including application logic ... and an XML processor ...* . Bayeh et al. do not explicitly provide for **an XSL processor ...** . However, it would be obvious to one with ordinary skill in the art at the time of the invention to know that Boag et al.'s invention provides for **an XSL processor...**, since Boag et al. further teach that *XML is emerging as a powerful methodology for representing document content, due to its ability to store data in a self-defining, portable manner. Style sheet languages such as XSL, along with their associated processors, are powerful tools for ... transforming documents encoded in one markup language into other markup languages such as HTML (HyperText Markup*

*Language) or WML (Wireless Markup Language) (Column 2, lines 20 – 28). It would have been obvious to one with ordinary skill in the art at the time of the invention to combine the invention of Bayeh et al. with that of Boag et al. because such a combination would allow *dynamic determination of the most appropriate location for applying style sheets* (first sentence of Boag et al.'s Abstract) *used by the rendering servlet for parsing the XML data stream* (last sentence of Bayeh et al.'s Abstract).*

22. **Regarding dependent claim 13, Bayeh et al. do not explicitly teach a plurality of servers operatively coupled to said database application, said plurality of servers including at least a first server ... , a plurality of clients including a first client that interacts with said database application ... .** However, Boag et al. teach that *FIG. 2 illustrates a data processing network 40 in which the present invention may be practiced. The data processing network 40 may include a plurality of individual networks, such as wireless network 42 and network 44, each of which may include a plurality of individual workstations 10. Additionally, as those skilled in the art will appreciate, one or more LANs may be included (not shown), where a LAN may comprise a plurality of intelligent workstations coupled to a host processor. Still referring to FIG. 2, the networks 42 and 44 may also include mainframe computers or servers, such as a gateway computer 46 or application server 47 (which may access a data repository 48). A gateway computer 46 serves as a point of entry into each network 44. The gateway 46 may be preferably coupled to another network 42 by means of a communications link 50a. The gateway 46 may also be directly coupled to one or more workstations 10 using a communications link 50b, 50c* (Column 5, lines 63 – 67 and

Art Unit: 2176

Column 6, lines 5 – 13), which provides for a **plurality of servers operatively coupled to said database application, said plurality of servers including at least a first server ... , a plurality of clients including a first client that interacts with said database application ...** . It would have been obvious to one with ordinary skill in the art at the time of the invention to combine the invention of Bayeh et al. with that of Boag et al. because such a combination would allow *dynamic determination of the most appropriate location for applying style sheets* (first sentence of Boag et al.'s Abstract) *used by the rendering servlet for parsing the XML data stream* (last sentence of Bayeh et al.'s Abstract).

23. **Regarding independent claim 14**, the claim incorporates substantially similar subject matter as claim 1, and is rejected along the same rationale.

24. **Regarding dependent claim 15**, the claim incorporates substantially similar subject matter as claim 2, and is rejected along the same rationale.

25. **Regarding dependent claim 16**, the claim incorporates substantially similar subject matter as claim 3, and is rejected along the same rationale.

26. **Regarding dependent claim 18**, the claim incorporates substantially similar subject matter as claim 5, and is rejected along the same rationale.

27. **Regarding dependent claim 19**, the claim incorporates substantially similar subject matter as claim 6, and is rejected along the same rationale.

28. **Regarding dependent claim 20**, the claim incorporates substantially similar subject matter as claim 7, and is rejected along the same rationale.

Art Unit: 2176

29. Claims 4 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boag et al. (previously cited) and Bayeh et al. (previously cited) as applied to claims 1 – 3, 5 – 16, and 18 – 20 above, and further in view of Siyan (previously cited).

30. **Regarding dependent claim 4**, neither Bayeh et al. nor Boag et al. explicitly teach **the particular client is a Telnet client, the Telnet client communicates with a Telnet server to request data from said database application or providing said output ... includes the steps of sending the output to said Telnet server and said Telnet server providing said output to said Telnet client**. However, Siyan teaches that *to support a TELNET session, you must have a TELNET client component running at the user's workstation and a TELNET server running at the remote host. A TCP/IP session is setup between the TELNET client and the TELNET server. As the user types the keyboard commands, the characters are received by the TELNET server ...* (page 94, second paragraph block), which provides for **the particular client is a Telnet client, the Telnet client communicates with a Telnet server to request data from said database application** (page 103, Figure 2.17), and that *the results of the commands are sent by the TELNET server to the TELNET client. The TELNET client displays the results received from the TELNET server on the user workstation's display unit* (page 94, last paragraph block), which provides for **providing said output ... includes the steps of sending the output to said Telnet server using a recipient specific format and said Telnet server providing said output to said Telnet client**. It would have been obvious to one with ordinary skill in the art at the time of the invention to combine the teachings of Siyan with the combined inventions of Boag et al.

Art Unit: 2176

and Bayeh et al. because those skilled in the art know that *frequently, the term TCP/IP is used to refer to a group of protocols related to the TCP and IP protocols such as ... Terminal Emulation Protocol (TELNET)* (Siyan, page 11, last sentence), since the combined invention utilizes (TCP/IP) (Boag et al., Figure 2).

31. **Regarding dependent claim 17**, the claim incorporates substantially similar subject matter as claim 4, and is rejected along the same rationale.

32. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boag et al. (previously cited), Bayeh et al. (previously cited), and Siyan (previously cited) as applied to claims 4 and 17 above and further in view of Busey et al. (5764916).

33. **Regarding dependent claim 21**, neither Bayeh et al., Boag et al., nor Siyan explicitly teach **TML**. However, Busey et al. do teach that *the telnet chat client processes incoming messages containing html tags as follows. The telnet chat client parses the incoming data (step 210) to distinguish between html tags and characters to be displayed. If an html tag is detected (step 212), the tag is processed as appropriate (step 214). If an html tag is not detected (step 212), the incoming data is displayed on the chat screen of the telnet chat client computer (step 216). In either case, the telnet chat client then looks for more data to process (step 218), and either resumes parsing or idles if no incoming or outgoing message is present* (Column 4, lines 50 – 60), which provides that **the recipient specific format comprises telnet markup language (TML)**, in light of the broad interpretation being used by the Office as explained above in the rejection of the claim under 35 USC 112, first paragraph. Further, it would have

Art Unit: 2176

been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Boag et al., Bayeh et al., and Siyan with that of Busey et al. because such a combination would allow the users of Boag et al., Bayeh et al., and Siyan the benefit of *a method for real time network chat* (Column 2, line 47).

34. **Regarding dependent claim 22**, the claim incorporates substantially similar subject matter as claim 21, and is rejected along the same rationale.

35. Claims 23 – 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boag et al. (previously cited) and Bayeh et al. (previously cited) as applied to claims 1 – 3, 5 – 16, and 18 – 20 above, and further in view of Monday (US006480860B1).

36. **Regarding dependent claim 23**, neither Boag et al. nor Bayeh et al. explicitly teach ... **dumb terminal** ... However, Monday do teach that *terminal interface 140 is used to directly connect one or more terminals 165 to computer system 100. These terminals 165, which may be non-intelligent (i.e., dumb) terminals or fully programmable workstations, are used to allow system administrators and users to communicate with computer system 100* (Column 6, lines 21 – 26), which provides that **the client device identifier indicates at least one of a dumb terminal, a telnet terminal, a bar code scanner and a browser-less device**. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Boag et al. and Bayeh et al. with that of Monday because such a combination would provide the users of Boag et al. and Bayeh et al. the benefit of an apparatus and method that defines a markup language for accessing data in a database (Column 1, lines 49 – 51).

Art Unit: 2176

37. **Regarding dependent claim 24**, the claim incorporates substantially similar subject matter as claim 23, and is rejected along the same rationale.

38. **Regarding dependent claim 25**, the claim incorporates substantially similar subject matter as claim 23, and is rejected along the same rationale.

***Response to Arguments***

39. Applicant's arguments filed 2/13/04 have been fully considered but they are not persuasive.

40. In response to applicant's argument that "It is fully anticipated that the TML may change. It may no longer even be called the TML", it must be noted that the burden of proving that TML even existed at the time of the invention is on the Applicant.

41. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

42. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., support for a client that does not have a browser (page 16, last sentence of second paragraph), devices that may not include HTTP (page 18, line 11), etc.) are not recited in



Art Unit: 2176

the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

43. In response to Applicant's argument that the Examiner's suggestion that Boag's browser identifier may be used to determine a device type of dumb terminals ... fails to provide a reasonable expectation of success, it should be noted that the Examiner did not and does not suggest that Boag teaches such capabilities. Applicant should be apprised that Boag met and meets all or part of the claimed invention despite what the specification discloses as Applicant's actual invention.

44. In response to applicant's argument that "The purpose as well as the problems addressed by these two references are incompatible" (page 18, lines 3 – 4) and that "Not only is there no suggestion to combine the teachings of Bayeh and Boag with Siyan, but further, the asserted combination would render Boag inoperable or unsatisfactory for its intended purpose or changes Boag's principle of operation" (page 21, last sentence), the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

45. Applicant's arguments with respect to claims 21 – 25 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

46. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Hillery whose telephone number is (703) 305-4502. The examiner can normally be reached on M - F, 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2176

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**JOSEPH FEILD**  
**SUPERVISORY PATENT EXAMINER**

NH